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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/591,145

08/30/2006

Mitsunori Nakatani

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EXAMINER

MERSHON, JAYNE L

ART UNIT

PAPER NUMBER

1795

NOTIFICATION DATE

DELIVERY MODE

03/11/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com  
offserv@bipc.com

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No. 10/591,145	Applicant(s) NAKATANI ET AL.	
	Examiner Jayne Mershon	Art Unit 1795	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 26 February 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Jennifer K. Michener/  
Supervisory Patent Examiner, Art Unit 1795

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant argues that a first emulsion layer 21 of Hikoharu does not anticipate claim 1 because the layer does not include a peripheral portion. The examiner, in the office action dated 12/24/2010, used emulsion layer 21 to anticipate the first resin layer of claim 1 formed inside the mesh. The examiner further used Takeuchi to show the gelatine emulsion used by Hikoharu resulted in the resin layer 21 being inside the mesh as well as on the surface of the mesh. Due to the language of the claim, i.e. "a printing mask comprising", and the "printing mask includes", the resin layer extending slightly past the mesh as well as in the mesh is not excluded. Furthermore, the exact language from claim 1 regarding a peripheral portion is "a peripheral portion in which the first resin layer is formed, but the second resin layer is not formed". Contrary to applicant's assertion, Hikoharu does teach a peripheral portion where the first resin layer 21, which is both in the mesh and extending past the mesh, is formed and the second resin layer 22 is not formed. Applicant's reference to a peripheral portion formed by a resin layer directly on the mesh layer is arguing a limitation not claimed, i.e. the claim language states "a second resin layer that is formed directly on a surface of the first resin layer".

Applicant asserts the examiner did not provide any reasoning why the recited limitation of thickness for the emulsion is obvious. In the office action dated 12/24/2009, the examiner used case law as rationale, specifically *In re Aller* and *In re Antoine*, which rule on optimization of ranges. In the instant case, both the applicant and Hikoharu are using an inset of one resin layer from the other to prevent edge build-up. Hikoharu teaches the thickness of the second resin layer is a percentage based on the area of the pattern forming portion. Takeuchi teaches thickness of the mask and therefore emulsion thickness varies depending on a number of known variables. Hikoharu and Takeuchi teach the emulsion thickness is a 'result-effective variable' that can be optimized and prima facie obvious (see *In re Antoine*). Applicant does not argue why optimization in the instant case is not found by routine experimentation (see *In re Aller*). Further, applicant states there is no disclosure in Takeuch regarding screen thickness. It is the examiner's position that web thickness, i.e. the woven web that makes up the screen, correlates to screen thickness.